

From: Hee Kim
Sent: Monday, November 14, 2016 10:30 AM
To: After Final Practice <afterfinalpractice@USPTO.GOV>
Subject: Federal Circuit Bar Association P3 Comment Letter

Dear Sir/Madam,

Attached, please find the Comment Letter on the Post-Prosecution Pilot Program (P3) submitted by the Federal Circuit Bar Association. A copy is also sent via mail.

Respectfully,

Hee Kim
Committee, Pro Bono and CLE Coordinator
Federal Circuit Bar Association
1620 I Street, NW Suite 801
Washington, DC 20006
P - 202-536-4160
F - 202-833-1061

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November 14, 2016

United States Patent and Trademark Office,
Mail Stop Comments – Patents
Office of Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention of Raul Tamayo

The deadline for public comment is November 14, 2016.

**Re: Comments By The Federal Circuit Bar Association
(FCBA) Regarding The P3 Program**

On July 11, 2016 the USPTO instituted a P3 Program as a pilot program through January 2017, and requested public comment. The Federal Circuit Bar Association (“FCBA”) appreciates the opportunity to comment on the USPTO’s P3 Program.

The FCBA, a national bar association, unites the different interests drawn before the Court of Appeals for the Federal Circuit (CAFC) and the tribunals which it reviews. Congress conferred on the Federal Circuit national appellate jurisdiction in a number of complex litigation areas, including matters involving intellectual property. The FCBA seeks to serve the administration of justice in the CAFC by maintaining and raising the standards of proficiency, integrity, and ethics in the practice of law before the Federal Circuit. In the context of this letter, we speak on behalf of our private sector members. Given their own roles, government members have not participated in the preparation or submission of this letter.

I. Summary

The FCBA membership is in general support of the P3 Program as an alternative option within the existing after final



practice before the USPTO. Based on feedback from the FCBA membership, various implementation procedures of the P3 Program warrant further consideration and possible attention. In its continued spirit of cooperation with the USPTO, and in response to feedback from FCBA members raised over the duration of the P3 Program to date, the FCBA hereby provides comments regarding specific provisions of the current P3 Program. The FCBA reserves comment with regard to many aspects of the P3 Program, with notable exceptions being the timing of the PC Requests and aspects of the ensuing P3 Conference with a panel of Examiners.

Comments are set forth below with regard to each of the various provisions of the P3 Program as set forth in Section “II.” Of the original July 11, 2016 Notice from the Federal Register:

II. P3 Participation Requirements and Procedures

A. P3 Participation Requirements

To be eligible to participate in the P3, an application must contain an outstanding final rejection and be (i) an original utility non-provisional application filed under 35 U.S.C. 111(a), or (ii) an international utility application that has entered the national stage in compliance with 35 U.S.C. 371 (see 37 CFR 1.491). A continuing application (e.g., a continuation or divisional application) is filed under 35 U.S.C. 111(a) and is thus eligible to participate in the P3. Reissue, design, and plant applications, as well as reexamination proceedings, are not eligible to participate in the P3.

A request for a response under 37 CFR 1.116 to be considered under the P3 must include the following items: (1) A transmittal form, such as form PTO/SB/444, that identifies the submission as a P3 submission and requests consideration under the P3; (2) a response under 37 CFR 1.116 comprising no more than five pages of argument; and (3) a statement that the applicant is willing and available to participate in the conference with the panel of examiners. Optionally, a P3 request may include a proposed non-broadening amendment to a claim(s).

Only one P3 request will be accepted in response to an outstanding final rejection. If prosecution is reopened and the Office subsequently issues a new final rejection, the filing of a P3 request in response to the new final rejection is permitted. Once a P3 request has been accepted in response to a final rejection, no additional response under 37 CFR 1.116 to the same final rejection will be entered, unless the examiner has requested the additional response because the examiner agrees that it would place the application in condition for allowance.

There is no fee required to request consideration under the P3. All papers associated with a P3 request must be filed via the USPTO's Electronic Filing System-Web (EFS-Web).

To be eligible to participate in the P3, an applicant cannot have previously filed a proper request to participate in the Pre-Appeal program or a proper request under AFCP 2.0 in response to the same outstanding final rejection, and once a P3 request is accepted, neither a request to participate in the Pre-Appeal program nor a request for consideration under AFCP 2.0 will be accepted for the same outstanding final rejection.

FCBA Comments:

The FCBA membership believes that the P3 Program offers a blended alternative to the existing after final practice, and should be retained as a cost effective, efficient addition to USPTO practice. The P3 Program offers the advantages of meeting with a panel of Examiners (as is the case with the Pre-Appeal program) rather than a single Examiner as in AFCP 2.0. This provides opportunity for objective viewpoints to enter the after final discussion between an applicant and the USPTO, without the cost of the Appeal Process.

In addition, the P3 Program allows for the ability to propose claims amendments. However, some concern was expressed that the three member panel should preferably include two examiners who are objective in offering de novo review of the record. For example, when a patent application is under final rejection by a junior Examiner and his/her primary Examiner, the P3 panel should include two Examiners in addition to the junior examiner and his/her primary Examiner.

Some concern was raised as to whether Examiners who participate on a P3 Program panel would be allocated sufficient other time so as not to overly burden their examining obligations. Appropriate other time could assist in ensuring a robust conference will take place in the after final practice.

1. TIMING OF THE P3 REQUEST

A P3 request must be filed within two months from the mailing date of a final rejection and prior to filing a notice of appeal. A P3 request will be deemed untimely if it is filed (i) more than two months from the mailing date of the final rejection, (ii) in an application that does not contain an outstanding final rejection (e.g., a P3 request will not be accepted in response to a second action non-final rejection), (iii) in response to a final rejection for which a proper AFCP 2.0 request has been filed, (iv) on or after the date a RCE or notice of appeal is filed in response to the same outstanding rejection, or (v) on or after the date an express abandonment is filed. For information on how the Office will process an untimely P3 request, refer to Section II.B.1 of this notice. For information on how a P3 request will be treated if a RCE, notice of appeal, or express abandonment is filed subsequent to the filing of the P3 request, but prior to a decision on the P3 request, refer to Section II.B.4 of this notice.

FCBA Comments:

A two month window from the mailing date of a final rejection for filing a P3 request is deemed appropriate.

2. TRANSMITTAL FORM

A P3 request must include a transmittal form. The Office advises the use of form PTO/SB/444, which is available at <http://www.uspto.gov/forms/index.jsp>, as the transmittal form. Use of form PTO/SB/444 will help the Office to quickly identify P3 requests and facilitate timely processing. In addition, form PTO/SB/444 will help applicants understand and comply with the requirements and procedures of the P3. Under 5 CFR 1320.3(h), form PTO/SB/444 does not collect “information” within the meaning of the Paperwork Reduction Act of 1995.

FCBA Comments:

None

3. RESPONSE UNDER 37 CFR 1.116

A P3 request must include a response under 37 CFR 1.116. The response must be a separate paper from the transmittal form, and must comprise no more than five pages of arguments. Arguments are limited to appealable, not petitionable, matters (e.g., an argument that the final rejection was premature is a petitionable matter—see MPEP § 706.07(c)). The Office considers arguments as encompassing, e.g., conclusions, definitions, claim charts, and diagrams. If the applicant opts to include a proposed amendment in the response under 37 CFR 1.116, as further discussed at Section II.A.5 of this notice, arguments presented in the response may be directed to the patentability of the proposed amended claim(s). The sheet(s) of the response containing a proposed amendment will not count towards the five-page limit. If the applicant opts to include an affidavit or other evidence as part of the response, entry of the affidavit or other evidence will be governed by 37 CFR 1.116. See MPEP 714.12. In addition, the affidavit or other evidence will count towards the limit of no more than five pages of arguments.

Form PTO/SB/444, or an equivalent transmittal that does not include arguments, will not count towards the five-page limit. Additionally, a page of the response that consists solely of, for example, a signature will not be counted toward the five-page limit. Thus, for example, a response that includes five pages of arguments and a sixth page that includes conclusions and/or definitions would be treated as exceeding the five-page limit. Furthermore, an applicant may not circumvent the five-page limit by filing arguments in multiple separate documents. For example,

if an applicant files one document containing five pages of arguments and an additional document containing arguments, the two documents will be considered together to ascertain whether the five-page limit has been exceeded.

The response may be single spaced, but must comply with the requirements of 37 CFR 1.52(a). Additionally, the response may refer to an argument already of record rather than repeat the argument. This should be done by referring to the location of the argument in a prior submission and identifying the prior submission by title and/or date (e.g., see the argument at pages 4-6 of the paper titled "Applicant's Response to Final Office Action" filed on October 1, 2015). A reference to "the arguments of record" or "the paper dated X" without a pinpoint citation will not be considered under the P3.

FCBA Comments:

None

4. CONFERENCE PARTICIPATION STATEMENT

The P3 request must include a statement by the applicant that the applicant is willing and available to participate in the conference with the panel of examiners. Form PTO/SB/444 includes the required conference participation statement.

After the Office initially verifies that a P3 request is timely and compliant, as further discussed at Section II.B.1 of this notice, the Office will contact the applicant to schedule the conference. If within ten calendar days from the date the Office first contacts the applicant, the Office and the applicant are unable to agree on a time to hold the conference, or the applicant declines to participate in the conference, the request will be deemed improper and treated in accordance with the discussion at Section II.B.1 of this notice.

The applicant may participate in the conference in-person, by telephone, or by a video conferencing tool set up by the Office, such as WebEx®. The conference will permit the applicant to present to the panel of examiners in a manner similar to how an applicant presents an argument in an ex parte appeal before the PTAB. The applicant's participation in the conference will be limited to 20 minutes.

The applicant should advise the Office of any special needs as soon as possible before participating in a conference. Examples of such needs include an easel for posters or a projector. The applicant should not make assumptions about the equipment the Office may have on hand for the conference. Section II.B.2 of this notice provides more information regarding the applicant's participation in the conference.

FCBA Comments:

Concern was raised over the 10 calendar day limit associated with a P3 Conference. It is unclear whether the P3 Conference is to be conducted within the 10-day period, or merely scheduled within the 10-day period and then allowed to occur at a later point in time. If the former, concern was raised that this could impose an undue burden on a patent applicant absent some degree of flexibility in extending the 10-day period, particularly for applicants who would prefer to conduct the conference in person but who must travel from out of town.

Some FCBA members suggested that if the P3 request is filed earlier within the 2 month window following the mailing date of a final rejection, then scheduling of the P3 conference should be permitted to occur at any time up to and including 10 days following the end of the 2 month window. This would offer greater time flexibility in the P3 conference planning, scheduling and attendance.

5. OPTION TO PROPOSE AMENDMENT

The response under 37 CFR 1.116 included with a P3 request optionally may include a proposed amendment to a claim(s). Entry of any proposed amendment after a final Office action is governed by 37 CFR 1.116. See MPEP 714.12. In addition, a proposed amendment under the P3 may not broaden the scope of a claim in any aspect. For the purposes of the P3, the analysis of whether a proposed amendment to a claim impermissibly would broaden the scope of the claim will be analogous to the guidance set forth in section 1412.03 of the MPEP for determining whether a reissue claim has been broadened.

A proposed amendment that focuses the issues with respect to a single independent claim is the type of proposed amendment that provides the best opportunity for leading to the application being placed into condition for allowance. A proposed amendment that contains extensive amendments (either in terms of the nature of the amendment or number of claims to be amended) probably will require extensive further consideration and thus likely would not be effective to place the application in condition for allowance. Extensive amendments will be considered only to the extent possible under the time allotted to the examiner under the P3.

The sheet(s) of the response containing a proposed amendment will not count towards the five-page limit discussed at Section II.A.3 of this notice. In accordance with 37 CFR 1.121(c)(1), the sheet(s) of the response containing the proposed amendment may not contain arguments.

FCBA Comments:

The possibility of submitting an amendment was deemed a positive aspect of the P3 program by many FCBA members.

B. P3 Procedures

1. TECHNOLOGY CENTER REVIEW

After receipt of a P3 request, the relevant technology center will review the request to verify that it is timely, includes a transmittal form, a response under 37 CFR 1.116 comprising no more than five pages of arguments (exclusive of any proposed amendment), and the conference participation statement, and otherwise complies with the requirements of the P3 set forth at Section II.A of this notice. If the request is timely and compliant, the technology center will contact the applicant to schedule the conference.

If the review finds that the request is untimely or otherwise fails to comply with the requirements of the P3, a conference will not be held. The response and any proposed amendment filed with the request will be treated under 37 CFR 1.116 in the same manner as any non-P3 response to a final rejection (except that if the request fails to comply because a P3 request previously has been accepted in response to the same final rejection, the response and any proposed amendment will be entered only if the examiner requests them, as mentioned earlier at Section II.A of this notice). The next communication issued by the Office will indicate the reason that the request was found to be untimely or otherwise non-compliant, the result of the treatment under 37 CFR 1.116 of the response and any proposed amendment filed with the request, and the time period for the applicant to take any further action that may be required as dictated by the facts. For example, if the response and any proposed amendment filed together with an untimely or otherwise non-compliant P3 request fails to place the application in condition for allowance, the next Office communication will be an advisory action. On the other hand, if the response and any proposed amendment is enterable under 37 CFR 1.116 and places the application in condition for allowance, the next Office communication will be a notice of allowability.

If the review of a P3 request finds that the request is timely and complies with the requirements of the P3, but the technology center reviewing the request has reached its limit of 200 compliant requests accepted, a conference will not be held. In this situation, the response and any proposed amendment filed with the request will be treated under 37 CFR 1.116 in the same manner as any non-P3 response to a final rejection. The Office may need to take appropriate measures to adjust an examiner's workload if the volume of requests for a P3 conference with any particular examiner becomes excessive.

It is critical for P3 participants to understand that the filing of a P3 request will not toll the six-month statutory period for reply to the final rejection. To avoid abandonment, further action, such as the filing of a notice of appeal or RCE, will need to be taken within the six-month statutory period for responding to the final rejection, unless the applicant receives written notice from the Office that the application has been allowed or that prosecution is being reopened.

FCBA Comments: None

2. The Post-Prosecution Pilot Conference

After the Office initially verifies that a P3 request is timely and compliant as discussed at Section II.B.1 of this notice, a Supervisory Patent Examiner (SPE) (preferably the SPE of the examiner of record) will coordinate a panel experienced in the relevant field of technology to review the response under 37 CFR 1.116 filed with the P3 request. The panel may include the examiner of record, the SPE, and a primary examiner (preferably the signing primary examiner for the examiner of record, if the examiner of record is a junior examiner). Every reasonable attempt will be made to select panel members with the most expertise in the relevant technological and legal issues raised by the application under consideration.

Concurrently, the Office will contact the applicant to schedule the conference. The applicant may arrange to participate in-person, by telephone, or by a video conferencing tool, such as WebEx®. Although the Office will make every reasonable attempt to accommodate the applicant and timely schedule the conference, scheduling of the conference lies within the full discretion of the Office. If within ten calendar days from when the Office first contacts the applicant, the Office and the applicant are unable to agree on a time to hold the conference, or if the applicant declines to participate in the conference, the request will be deemed improper and treated in accordance with the discussion at Section II.B.1 of this notice. If the examiner of record is unable to participate on the scheduled date of the conference and rescheduling is not possible, the conference will proceed and the other conferees will gather input from the examiner prior to the conference if possible. The remaining conferees may, at their discretion, opt to include in the panel another examiner from the pertinent art.

The conference will begin with the applicant's presentation, which is limited to 20 minutes. The applicant will be excused from the conference at the end of the presentation. Any materials used by the applicant during the presentation, e.g., a PowerPoint® or exhibit, will be placed in the file and will not count against the five-page limit on arguments. Entry of an affidavit or other evidence included as part of the presentation materials is governed by 37 CFR 1.116. See MPEP 714.12.

The applicant may present on appealable, not petitionable, matters (e.g., applicant may not present an argument that the final rejection was premature). The applicant may present arguments directed to the outstanding record, and, if the response filed with the P3 request includes a proposed amendment, the applicant also may present arguments directed to the patentability of the amended claim(s).

FCBA Comments:

See comments above in Section II.A.4.



3. THE NOTICE OF DECISION FROM POST-PROSECUTION PILOT CONFERENCE

The applicant will be informed of the panel's decision in writing via the mailing of a Notice of Decision from Post-Prosecution Pilot Conference (form PTO-2324). For an accepted P3 request (refer to Section II.B.1 of this notice for the procedure that will be followed for an untimely or non-compliant P3 request), the notice of decision will indicate one of the following: (a) Final rejection upheld; (b) allowable application; or (c) reopen prosecution. In appropriate circumstances, a proposed amendment may accompany the notice of decision proposing changes that, if accepted, may result in an indication of allowability.

FCBA Comments:

None

A. FINAL REJECTION UPHELD

If the notice of decision indicates “final rejection upheld,” the notice of decision will not contain any additional grounds of rejection or any restatement of a previously made rejection. Instead, the notice of decision will summarize the status of the pending claims (allowed, objected to, rejected, or withdrawn from consideration) and the reasons for maintaining any rejection, and include an indication of any rejection that has been withdrawn as a result of the conference.

For a P3 request that includes a proposed amendment as part of the response under 37 CFR 1.116, a notice of decision indicating “final rejection upheld” also will communicate the status of the proposed amendment for purposes of appeal (entered/not entered). If the proposed amendment is entered for purposes of appeal, and the notice of decision indicates which individual rejection(s) set forth in the final Office action would be used to reject the amended claim(s), then any subsequent examiner's answer may include the rejection(s) of the amended claim(s), and such rejection(s) made in the examiner's answer would not be considered a new ground of rejection.

If a notice of decision indicates “final rejection upheld,” the time period for taking further action in response to the final rejection expires on (1) the mailing date of the notice of decision; or (2) the date set forth in the final rejection, whichever is later. As discussed previously, to avoid abandonment, the applicant must file a notice of appeal or RCE within the statutory period for response to the final rejection. Extensions of time may be obtained under 37 CFR 1.136(a), but the period for response may not be extended beyond the six-month statutory period for response.

A notice of decision indicating “final rejection upheld” is not petitionable. A decision to maintain a rejection is subject to appeal. Accordingly, the Office will not grant a petition seeking

reconsideration of a panel decision upholding the final rejection. The applicant maintains the right of appeal under 35 U.S.C. 134 by filing a notice of appeal and an appeal brief and having the appeal considered by the PTAB.

FCBA Comments:

None

B. ALLOWABLE APPLICATION

If the notice of decision indicates “allowable application,” the notice of decision will be mailed concurrently with a Notice of Allowance, and the notice of decision will state that the rejection(s) is/are withdrawn.

FCBA Comments:

None

C. REOPEN PROSECUTION

If the notice of decision indicates “reopen prosecution,” the notice of decision will state that the rejection(s) is/are withdrawn and a new Office action will be mailed. The notice of decision also will state that no further action is required by the applicant until further notice.

FCBA Comments:

None

4. ACTIONS THAT WILL TERMINATE A POST-PROSECUTION PILOT CONFERENCE

If the applicant files any of the following after the date of filing a P3 request, but prior to a notice of decision from the panel of examiners, processing of the P3 request will end without a decision on the merits of the P3 request: a notice of appeal; a RCE; an express abandonment under 37 CFR 1.138; a request for the declaration of interference; or a petition requesting the institution of a derivation proceeding. The response and any proposed amendment filed with the request will be treated under 37 CFR 1.116 in the same manner as any non-P3 response to a final rejection. The next communication issued by the Office will indicate the reason that processing of the P3 request was terminated, the result of the treatment under 37 CFR 1.116 of the response and any proposed amendment filed with the request, and the time period for the applicant to take any further action that may be required as dictated by the facts.

In addition, as stated earlier, once a P3 request has been accepted in response to a final rejection, no additional response under 37 CFR 1.116 to the same final rejection will be entered, other than

one that the examiner has requested because the examiner agrees it would place the application in condition for allowance. This condition of the P3 holds true regardless of whether the additional response is filed prior to, on the same day as, or after a notice of decision from the panel of examiners.

Finally, at any point during the processing of a P3 request, the examiner may enter an Examiner's Amendment placing the application in condition for allowance.

FCBA Comments:

None

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. E. Brookshire', with a long horizontal flourish extending to the right.

James E. Brookshire,
Executive Director